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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,746	05/31/2001	Bijan Tadayon	111325-63	5716

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EXAMINER

SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,746

Applicant(s)

TADAYON ET AL. 

Examiner

Cristina Owen Sherr

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This communication is in response to the amendment filed July 8, 2004. Claims 1, 9 and 14 have been amended. Claims 1-14 are pending in this case.

Response to Arguments

2. Applicant's arguments, see amendment, filed July 8, 2004, with respect to the rejections of claims 1 and 9 under Hurtado (US 6,611,812) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of additional art.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-14 rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al., (US 5,638,443).

5. Regarding claim 1 –

Stefik teaches a method of transferring and managing rights from user to another comprising (e.g. column 18 lines 9-22 and Fig. 14): associating usage rights, transfer permission information, and a current user identification flag, with digital content (e.g. column 6 lines 16-48 and Fig. 1); electronically distributing a digital work including the content to a first user in accordance with the usage rights and setting the current user

identification flag to correspond to the first user (e.g. column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14); and transferring the digital work to a second user and setting the current user identification flag to correspond to the second user, wherein usage rights are allocated based on a percentage partially allocated between the first user and the second user (e.g. column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14).

6. Regarding claim 2-8 –

Stefik discloses a method as recited in claim 1, wherein said transferring step comprises changing the usage rights in accordance with the transfer to the second user; wherein said changing step comprises changing the usage rights to permit use of the content by the second user and to prohibit use of the content by the first user; further comprising receiving notification that the user desires to distribute the digital work to a second user; wherein said transferring step comprises transferring usage rights without change for remaining usage period of time to the second user; wherein said transferring step further comprises downloading the content from the first user to the second user; wherein said transferring step further comprises downloading the content from a distributor to the second user; and further comprising checking for transfer permission prior to said transferring step (e.g. col 6 lines 16-48 and column 18 lines 9-22).

7. Regarding claim 9-

Stefik discloses a system for transferring digital works from one user to another user comprising: digital content; a usage rights module containing usage rights information associated with the content for a first user; a transfer permission module containing transfer permission information for the content; a current user identification module

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containing identity information indicating the identity of the first user; and means for manipulating said current user identification module to change the current user identification flag f the identity information from a current user to a second user upon transferring the content from the first user to the second user, wherein usage rights are allocated based on a percentage partially allocated between the first user and the second user (e.g. col 6 lines 16-48 and column 18 lines 9-22).

8. Regarding claims 10-14 –

Stefik discloses a system as recited in claim 9, further comprising means for changing the usage rights in accordance with a change in identity information; wherein said usage rights module and said digital content are encrypted; wherein said usage rights module and said digital content are attached to one another as an encapsulated element; wherein said transfer permission module and said current user identification module are located remotely from said encapsulated element; wherein said means for manipulating said current user identification module is responsive to a notification that the first user desires to distribute the digital work to the second user (e.g. col 11 ln 16-27, col 11 ln 32-42).

8. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Ginter et al (US 6, 427,140) discloses systems and methods for secure transaction management and electronic rights protection.

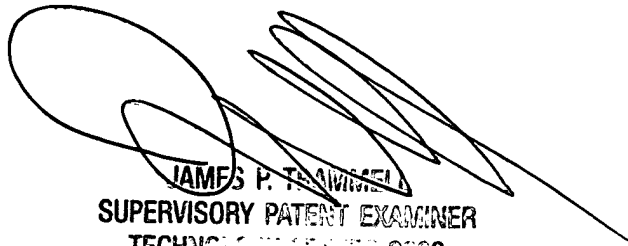
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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